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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/070,292	03/05/2002	Hirokazu Tanaka	204552022500	3051

7590 12/23/2003
Barry E Bretschneider
Morrison & Foerster
2000 Pennsylvania Avenue NW
Washington, DC 20006-1888

EXAMINER

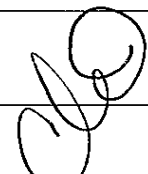
BARR, MICHAEL E

ART UNIT	PAPER NUMBER
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1762

DATE MAILED: 12/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/070,292	Applicant(s) TANAKA ET AL.	
	Examiner Michael Barr	Art Unit 1762	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 June 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/17/2003 has been entered.

Response to Arguments

2. Applicant's arguments and amendments, filed 10/17/2003, and entered as per the RCE request filed 11/17/2003, have been fully considered and reviewed by the examiner. Claims 1-8 are pending.

The applicant has argued that the Boeke reference would not produce the claimed charged and scattered substances on the surface of the polymeric material as Boeke uses long wavelength layers. The examiner is not persuaded by the applicant's argument. The applicant has not provided a factual showing or evidence that the charged and scattered substances can only be produced by wavelengths less than 600 nm. If the applicant can provide such a showing, then the examiner would withdraw the rejection. Without such a showing, it is the examiner's position that Boeke would have provided the claimed charged and scattered substances by exposure to the laser, as Boeke teaches the claimed inorganic filler and exposure to the laser. Furthermore, the mere observation of still another beneficial result of an otherwise old process

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cannot form the basis of patentability (*Allen et al. vs. Coe* 57 USPQ 136). As far as the claimed laser wavelength requirements, it would have been obvious to one skilled in the art to use the YAG laser at a wavelength of 193-308 nm, in Boeke et al., with the expectation of providing the desired electroless plating pretreatment on the polyphenylene sulfide article, since it is shown by Hiraoka et al. that such a wavelength is conventionally used in the art for YAG lasers used to pretreat polyphenylene sulfide molded articles for electroless plating, which is the desire of Boeke et al. The combination of Boeke and Hiraoka is predicated on the laser wavelength of Hiraoka providing substantially equivalent results as that of Boeke. If the applicant can provide a showing that the laser wavelength, in the claimed range, provides unexpected results (i.e. providing the charged and scattered substances), while that of Boeke would not, then the examiner would withdraw the rejection.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-2 and 5-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boeke et al. in view of Hirsch et al. and Hiraoka et al.

Boeke et al., Hirsch et al., and Hiraoka et al. are applied here for the same reasons as given above and in paragraph 3 of the previous office action, mailed 7/17/2003. It is the examiner's position that above combination would have provided the claimed charged and

scattered substances by exposure to the laser, as the references teach the claimed inorganic filler and exposure to the laser. However, if the applicant can provide a factual showing or evidence that the charged and scattered substances can only be produced by wavelengths less than 600 nm, then the examiner would withdraw the rejection.

5. Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hiraoka et al. in view of Hirsch et al. and Boeke et al.

Hiraoka et al., Hirsch et al. and Boeke et al. are applied here for the same reasons as given above and in paragraph 4 of the previous office action, mailed 7/17/2003. Hiraoka et al. teaches using a YAG laser to irradiate the polyphenylene sulfide article, where the wavelength used is 193-308 nm (Col. 3, lines 3-23). It is the examiner's position that above combination would have provided the claimed charged and scattered substances by exposure to the laser, as the references teach the claimed inorganic filler and exposure to the laser. However, if the applicant can provide a factual showing or evidence that the charged and scattered substances can only be produced by wavelengths less than 600 nm, then the examiner would withdraw the rejection.

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Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Barr whose telephone number is 703-305-7919. The examiner can normally be reached on Monday-Thursday 6:00 am-4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive Beck can be reached on 703-308-2333. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

Michael Barr
Primary Examiner
Art Unit 1762

A handwritten signature in black ink, appearing to read 'Michael Barr', with a long horizontal flourish extending to the right.

MB
November 26, 2003